

REMARKS

Claims 1-3 and 5-12 are pending in the application. Claim 1 is amended and is supported by the specification as originally filed, particularly: page 5, lines 17-21 in relation to the amendment of step d) of claim 1; and page lines 29-31 and page 6, lines 23-31 in relation to the amendment of steps g)-h) of claim 1. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Consideration of the amendments and remarks after final is proper under 37 C.F.R. §1.116 because 1) the amendment does not add new matter; 2) the amendment does not require further search or consideration; 3) the amendments and remarks address issues raised for the first time in the final Office Action; and 4) the amendment and remarks place the application in condition for allowance, or at least in better condition for appeal, should an appeal be necessary. Entry and consideration of the amendment and remarks is thus respectfully solicited.

The Office Action, which presents all new grounds of rejection, has been made final. It is indicated in the Office Action that Applicants' amendments necessitated the new grounds of rejection, making the Office Action final. Applicants respectfully assert the finality of the rejection is premature, and should be withdrawn. According to MPEP 706.07(a), finality of a second office action is not proper when:

*Under present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).*

Applicants' amendment could have been anticipated by the Examiner. It is the Examiner's duty to consider not only the claims as they stand, but any logical amendments that might be made in response to a rejection. Thus, the Examiner should have considered all available art over all pending claims at the time of the rejection, and any features in the specification that readily could have been added to the claims. The recitation of the thumbnail identifier added to the claims in the amendment of 29 January 2008 is clearly set forth in the specification at least at pages U.S. Serial No. 10/510,487

4 and 6, and therefore could have been anticipated as a feature to be added by the Examiner during the first Examination. Thus, finality of the rejection should be withdrawn.

Claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg (U.S. Patent No. 7,155,070) in view of Squilla et al. (U.S. Patent No. 6,623,528), referred to hereafter as Squilla. Applicants respectfully traverse the rejection, and request reconsideration in view of the following amendments and remarks.

Applicants respectfully submit that Steinberg does not disclose thumbnail identifiers. Indeed, Steinberg does not disclose, as step a) of claim 1 of the present application, an electronic message including "at least one identifier of a photographic support comprising a plurality of thumbnails, each of said thumbnails being assigned a thumbnail identifier". Steinberg only discloses that pictures data are sent to a cell phone equipped with a visual display, to display on the cell phone the corresponding pictures/images. Thus, a consumer can preview images of developed film sent from a film service facility to the cell phone (see, in Steinberg: column 2, lines 7-9 and lines 11-14). Steinberg only discloses that a print order of said images can then be placed through the cell phone (see, in Steinberg: column 2, lines 16-18).

Steinberg does not disclose, as steps g) and h) of claim 1 of the present application: "the display on the screen of the terminal of all the identifiers of said respective thumbnails," or "selecting at least one thumbnail identifier." Steinberg only discloses that the consumer views the pictures and can make decisions concerning how many prints (i.e., a number of prints) of each image to order from the cell phone (see, in Steinberg: abstract, lines 11-14; figure 3B). Figures 3A-3C of Steinberg only show that images are displayed one by one. Therefore, Steinberg does not disclose the display of all the identifiers specific to the thumbnails (reference, in the present application: step g) of claim 1 and page 6, lines 24-25).

Applicants respectfully submit that, contrary to the process of the invention, the process of Squilla described by the flow chart of figure 4 is not continuously carried out on a single terminal. Squilla discloses that an index print is

generated by a retailer with an index printer, in a form of a paper media (see, in Squilla: column 2, lines 63-65; column 5, lines 16-19); the index print is sent to a customer who selects the desired images from the index print by checking a box or marking the thumbnail image on the index print (see, in Squilla: column 4, lines 22-25); and then the index print is returned to the retailer, who scans it. The process disclosed in Squilla is therefore completely different from the whole electronic process defined in Applicants' claim 1 that is entirely performed from a terminal having a keyboard and a display screen.

One of the ordinary skill in the art would not have been capable of incorporating the teaching of Squilla about image identification assigned to thumbnails into Steinberg's invention. The reason is that Steinberg only discloses that images to be printed are displayed on the cell phone display one by one, as shown in Steinberg figure 3B, which shows one image and the written recommendation to view a next image. Therefore, starting from Steinberg and knowing the teaching of Squilla, one of the ordinary skill in the art would have had only the information about a selection of images made manually in marking identifiers on a hard copy of a photographic index. One of ordinary skill in the art would have found no technical information about how to modify Steinberg's process to obtain the display on the terminal screen of Steinberg of the identifiers of a plurality of thumbnails corresponding to at least one photographic support having itself its own identifier, and the selection of at least one thumbnail identifier amongst said displayed thumbnail identifiers generating the automatic display of the corresponding images on the terminal screen.

Steinberg's method enables one to process a print order from a cell phone on which image adjustments (color, brightness, border around the image) can be made before processing the print order. The function of Steinberg's method is different from the digital process as defined in Applicants' claim 1. Therefore, the information about identifiers such as disclosed by Squilla wherein visual marks are inserted manually, by a customer, on a hardcopy index print, and then the index print is scanned by a retailer to retrieve the corresponding images, cannot be adapted to the process of Steinberg that enables one to preview and to adjust one image on a digital

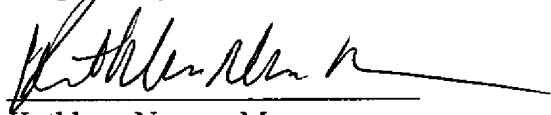
cell phone before making a print order. Even if one of the ordinary skill in the art would attempt to combine this information from Squilla with the process of Steinberg, for the reasons stated above, he/she would not have been capable to modify Steinberg's process with the information given by Squilla to get the process defined in Applicants' claim 1. Moreover, an *ex post facto* analysis should be avoided to conclude to a lack of inventive step of the claimed invention.

conclusion, the electronic process fully carried out on a terminal such as defined from step a) to step j) of Applicants' claim 1 cannot be obtained by combining the respective teachings of Steinberg and Squilla. In view of the above, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing remarks, claims 1-3 and 5-12 are considered to be in condition for allowance. Favorable action in the form of a Notice of Allowance is courteously solicited.

Should the Examiner require anything further to place the application in condition for allowance, it is respectfully requested the Examiner contact Applicants' undersigned representative to discuss the matter.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.